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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|------------------------|---------------------|------------------|
| 10/668,001 | 09/22/2003 | Philip Martin McGenity | HO-P02110US2 | 1938 |
| 26271 | 7590 | 03/28/2005 | EXAMINER | |
| FULBRIGHT & JAWORSKI, LLP 1301 MCKINNEY SUITE 5100 HOUSTON, TX 77010-3095 | | | SAYALA, CHRAYA D | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 1761 | |

DATE MAILED: 03/28/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

10/668,001

Applicant(s)

MCGENITY ET AL.

Examiner

C. SAYALA

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--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 09 March 2005 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:
- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
- Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The reply was filed after the date of filing a Notice of Appeal, but prior to the date of filing an appeal brief. The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS


3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
- (a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ They raise the issue of new matter (see NOTE below);
- (c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.
- NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).
4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
- The status of the claim(s) is (or will be) as follows:
- Claim(s) allowed: _____.
- Claim(s) objected to: _____.
- Claim(s) rejected: 21-30.
- Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: see attached.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). _____
13. ☐ Other: _____.



**CHHAYA SAYALA
PRIMARY EXAMINER**

Response to Arguments

Applicant's arguments filed 3/9/2005 have been fully considered but they are not persuasive.

Upon entering the proposed amendment, the following changes will be made to the Final action:

- Rejection at paragraph 1 will be withdrawn, based on applicant's remarks.
- Rejection at paragraph 2 will be maintained: Claims 21-27 will be rejected under 35 USC 103(a) as being unpatentable over Aga et al.
- Rejection at paragraph 3 will be maintained: Claims 21-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Scaglione et al. (US Patent 5000973) in view of CFR, Title 21, Part 101, Subpart B, Sec. 101.22 and further in view of Nabi et al. (US Patent 5472684).

With regard to the rejection over Aga et al. applicant states that Propolis does not fall within the definition provided in the specification. Specifically, applicant points to

"Any substance which is derived, obtained or extracted from a plant or plant part by conventional separation techniques."

Further applicant states that

"As taught by Aga et al. and known by those of skill in the art propolis does not fall under the scope of this definition. Propolis is not made by conventional separation techniques of plant materials; Propolis is made by bees collecting plant material."

And, "If the Examiner continues to maintain that Aga et al. is the basis for this rejection, the Examiner is requested to make of record the passage relied upon, or state for the record that no such teaching can be found in Aga et al. "

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The information on Propolis, the well-known natural antibiotic and natural preventive, was made of record on PTO-form 892 filed 12/9/05. In that piece of literature, the second paragraph states "What is Propolis? Propolis is a sticky resin that seeps from the buds of some trees and oozes from the bark of other trees, chiefly conifers. The bees gather Propolis....and carry it home in their pollen baskets".

This falls under the definition given in the specification that the substance is "derived" or "obtained" from a plant or plant part.

As for applicant requesting "to make record the passage relied upon", this prior art has already been made of record to establish what is commonly known: that Propolis is known as a "home remedy" and that Propolis is a sticky resin from tree buds, also a commonly known fact. Even if it is gathered by bees, it does not take away from the fact that it is from buds of trees, and the reference of Aga et al. shows an extract of Propolis, as defined by the specification.

Scaglione et al., CFR Title 21 and Nabi et al. are faulted for not teaching the limitation, "reduces malaodor in a pet" (claim 1).

The claims presented are composition claims. Scaglione et al. teaches using flavorants in a dough composition for pets. The CFR Title 21 teaches what these flavorants are as defined for the food art. And Nabi et al. further define particular flavorants useful for oral care. First, this rejection is made under 35 USC 103, and it is well established that a reasonable expectation of success, not absolute predictability is necessary for conclusion of obviousness, *In re Longi*, 225 USPQ 545, *In re Morston*, 1961 C.D. 330, *In re Clinton*, 188 USPQ 365, *In re O'Farrell*, 7 USPQ2d 1673, 1681

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(Fed Cir 1988). Second, in response to applicant's argument that the references do not teach reducing malodor, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. See *In re Casey*, 370 F.2d 576, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 312 F.2d 937, 939, 136 USPQ 458, 459 (CCPA 1963). The flavorants are the same and therefore it must be that this limitation is met because a compound and its properties are inseparable. *In re Papesch*, 137 USPQ 43 (CCPA 1963).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to C. SAYALA whose telephone number is 571-272-1405.

The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

C. SAYALA
Primary Examiner
Group 1700.